



OCT 04 2001

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| In re Application of LINIAL et al | : | |
| U.S. Application No.: 09/601,278 | : | DECISION ON PETITION |
| Int. Application No.: PCT/IL99/00057 | : | |
| Int. Filing Date: 29 January 1999 | : | UNDER 37 CFR 1.47(a) |
| Priority Date: 29 January 1998 | : | |
| Attorney Docket No.: P-1476-US | : | |
| For: AN AUTOMATIC METHOD OF | : | |
| CLASSIFYING MOLECULES | : | |

This is in response to applicants' "A Renewed Petition Under 37 C.F.R. 1.47(a)" filed 13 August 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

BACKGROUND

On 29 January 1999, applicants filed international application PCT/IL99/00057, which claimed priority of an earlier United States application filed 29 January 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 05 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 31 July 2000 (29 July 2000 was a Saturday).

On 31 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, authorization to charge the requisite basic national fee required by 35 U.S.C. 371(c)(1) and an unsigned declaration.

On 22 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 22 February 2001, applicants filed a petition under 37 CFR 1.47(a) along with a declaration signed by three of the four joint inventors and not signed by inventor Golan Yona.

On 12 June 2001, the PCT Legal Office of the USPTO mailed a decision dismissing the 22 February 2001 petition for failure to demonstrate that a bona fide attempt was made to present a copy of the complete application papers to Yona for signature and for failure to show that Yona refuses to join in the application.

On 13 August 2001, applicants filed the present renewed petition. The renewed petition states that it is accompanied by an affidavit from Renee Ben-Israel.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicants have previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, applicants have not demonstrated that a bona fide attempt was made to present a copy of the complete application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventor Yona for signature. The affidavit of Renee Ben-Israel states that a copy of the declaration and power of attorney was sent via facsimile to Yona on 03 October 2000 (see paragraph 7 of Ben-Israel's affidavit). However, the affidavit does not establish that any attempt was made to present the specification, claims, and drawings to Yona. Furthermore, Ben-Israel's affidavit specifically states, "I did not forward him a copy of the Subject Application." (See paragraph 8 of Ben-Israel's affidavit). Ben-Israel's affidavit states that statements made by Yona in an electronic mail message dated 02 November 2000 show that Yona reviewed the application (see paragraph 8 and Exhibit 4 of Ben-Israel's affidavit). Ben-Israel's affidavit further states that a letter dated 27 December 2000 indicates that Yona has "obtained a copy of the PCT" (see paragraph 9 and Exhibit 5 of Ben-Israel's affidavit). However, MPEP 409.03(d) requires that a bona fide attempt be made to present a copy of the application papers to the non-signing inventor for signature. No evidence has been provided regarding any such attempt by applicants. Therefore, it is unreasonable to conclude at the present time that Yona refuses to join in the application.

CONCLUSION

Because applicants have failed to satisfy item (2) above, the renewed petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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